

REMARKS

With entry of this amendment, claims 1, 5, 7, 10, 11, 14, 15, 28, and 29 have been amended, claims 4, 8, 9, 12, 13, 26, and 30-38 have been canceled and claims 39-41 have been added. Thus, claims 1, 5-7, 10, 11, 14, 15, 21-24, 28, 29, and 39-41 are pending in the subject application. Based on the following remarks, reconsideration and allowance of the application are respectfully requested.

Claim Rejections – 35 U.S.C. §112

Claims 1, 4-15, 21-26, and 28-29 stand rejected under 35 U.S.C. §112, second paragraph, for allegedly being indefinite. Claims 4, 8, 9, 12, 13, 25, and 26 have been canceled and Applicants respectfully traverse the 35 U.S.C. §112, second paragraph rejection of claims 1, 5-7, 10, 11, 14, 15, 21-24, and 28-29.

The Examiner states that claim 1 “is vague and indefinite what parameters are intended that designate a sample as satisfactory for preparing a specimen slide.” The test for definiteness under 35 U.S.C. §112, second paragraph, is whether “those skilled in the art would understand what is claimed when the claim is read in light of the specification.” *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576, 1 USPQ2d 1081, 1088 (Fed. Cir. 1986). Applicants respectfully submit that those skilled in the art would understand from reading claim 1 in its entirety that a positive designator is attached to the vessel if the solution containing the initial sample is satisfactory for preparing a specimen slide. The Examiner is inappropriately requiring Applicants to narrow claim 1 by specifically reciting an example of the criterion that render the solution containing the initial sample satisfactory for preparing a specimen slide. However, Applicants submit that doing so would unnecessarily limit Applicants’ patent protection. In addition, MPEP §2173.02 states that “if the language used by applicant satisfies the statutory requirements of 35 U.S.C. §112, second paragraph, but the examiner merely wants the applicant to improve the clarity or precision of the language used, the claim must not be rejected under 35 U.S.C. §112, second paragraph.”

The Examiner further states that claim 1 “is not clear what method is performed by the “manipulation designator designates” and what/how the required manipulation determined.” In the interest of compact prosecution, the offending language has been deleted from claim 1.

The Examiner asserts that “positive designator” will be interpreted as making a first optical measurement and making a determination about the sample based upon the first

measurement and that “manipulation designator” will be interpreted as performing the appropriate step so proper analysis can be achieved. The Examiner’s interpretations of “positive designator” and “manipulation designator” are improper. While claims should be given the broadest reasonable interpretation, the broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach (see MPEP §2111). It appears that, rather than reading the claim language in the context of the rest of the claim or in light of the specification, the Examiner is interpreting the claim language to fit within the teachings of the art identified by the Examiner. Applicants submit that such an interpretation is not consistent with the interpretation that those skilled in the art would reach. In addition, interpreting “positive designator” and “manipulation designator” in such a manner ignores the rest of the claim language. For example, the Examiner is apparently ignoring the claim elements of the positive designator being attached if the solution containing the initial sample is “satisfactory for preparing a specimen slide” and the manipulation designator being attached if the solution containing the initial sample “requires a manipulation to render the solution containing the initial sample satisfactory for slide preparation.”

Since the 35 U.S.C. §112, second paragraph rejection is improper for at least the reasons set forth above, Applicants respectfully request withdrawal of the 35 U.S.C. §112, second paragraph rejection of claims 1, 5-7, 10, 11, 14, 15, 21-24, and 28-29.

Claim Rejections – 35 U.S.C. § 102

Zahniser

Claims 1, 6, 9-11, 15, 22, 24, 26 and 28-29 stand rejected under 35 U.S.C. § 102(b) for allegedly being anticipated by USP 5,168,066 (“Zahniser”). In order to sustain a rejection under §102, each element in the rejected claim must be found, either expressly or inherently, in the cited reference. Claims 9 and 26 have been canceled and Applicants respectfully traverse the rejection of claims 1, 6, 10, 11, 15, 22, 24, and 28-29, since Zahniser does not disclose each and every element required by these claims.

In particular, independent claim 1 recites that the positive designator is attached if the solution containing the initial sample is satisfactory *for preparing a specimen slide*; and the manipulation designator is attached if the solution containing the initial sample requires a manipulation *to render the solution containing the initial sample satisfactory for slide preparation*. (Emphasis Added). Claims 6, 10, 11, 15, 22, 24, and 28-29 depend from claim 1,

and thus include the same limitations. Zahniser does not teach attaching a positive designator to the vessel if the solution containing the initial sample is satisfactory for preparing a specimen slide, or attaching a manipulation designator to the vessel if the solution containing the initial sample requires a manipulation in order to render the solution containing the initial sample satisfactory for slide preparation.

Despite this, the Examiner states that the claimed attachment of positive and manipulation designators may be read on the steps of recording the image and comparison to certain parameters to obtain a diagnosis taught by Zahniser. Applicants respectfully submit that this reading is contrary to the teachings of the specification, in view of which the application claims must be read. As discussed in the specification at p. 13, line 24 through p. 14, line 3, the designators can be physically or electronically attached to the sample vessel. Zahniser's recording of the image does not fall within this definition of a designator.

The Examiner also states (in the last paragraph on p. 5 of the Office Action dated 2/9/09) that (1) the claimed positive designator reads on Zahniser's alleged teaching of illuminating the sample to determine which specific stain was used, and (2) that the claimed manipulation designator reads on Zahniser's alleged teaching of determining the proper wavelength for analysis. However, these claim interpretations are not consistent with the interpretations discussed above, i.e., that the claimed attachment of positive and manipulation designators may somehow be read on Zahniser's steps of recording the image and comparison to certain parameters to obtain a diagnosis. Applicants respectfully request clarification on this issue from the Examiner.

For at least these reasons, Applicants respectfully submit that independent claim 1, along with those rejected claims which depend therefrom, are not anticipated by Zahniser, and respectfully request reconsideration and withdrawal of the claim rejections under 35 U.S.C. § 102(b) based on Zahniser.

Isenstein

Claims 1, 4-15, 21-26 and 28-29 stand rejected under 35 U.S.C. § 102(e) for allegedly being anticipated by US 2004/0253144 ("Isenstein"). In order to sustain a rejection under §102, each element in the rejected claim must be found, either expressly or inherently, in the cited reference. Claims 4, 8, 9, 12, 13, and 25 have been canceled and Applicants respectfully traverse

the rejection of claims 1, 5-7, 10, 11, 14, 15, 21-24, and 28-29, since Isenstein does not disclose each and every element required by these claims.

In fact, Applicants submit that Isenstein does not teach *any* of the actions set forth in independent claim 1, and it is not at all apparent to the Applicants why/how Isenstein is being used by the Examiner for making the rejections. The Examiner simply states that “Figures 5-12 teach various decision trees that encompass the claimed automated method of classifying and analyzing the samples.” However, Isenstein actually teaches a method for qualifying an automated biological screening system to ensure that it consistently provides accurate results in identifying the most pertinent biological objects for subsequent review by a technician, which is not at all similar to the claimed method of classifying a cytological sample.

Claim 1 recites attaching a positive designator to the vessel or attaching a manipulation designator to the vessel. Isenstein does not teach attaching a positive designator to the vessel or attaching a manipulation designator to the vessel. Further, Isenstein does not teach or suggest that the positive designator is attached if the solution containing the initial sample is satisfactory *for preparing a specimen slide* or that the manipulation designator is attached if the solution containing the initial sample requires a manipulation *to render the solution containing the initial sample satisfactory for slide preparation*. (Emphasis added).

Nevertheless, the Examiner states that Isenstein’s alleged teaching of procuring a sample, generating a slide preparation from the sample, reviewing/marking/counting the cell, and determining if the slide is properly prepared reads on the claimed positive designator. The Examiner further states that Isenstein’s steps of determining if the sample requires further manipulation and processing the sample appropriately read on the claimed manipulation designator. However, these interpretations ignore the claim limitations of a positive designator being attached if the solution containing the initial sample is satisfactory *for preparing a specimen slide*; and a manipulation designator being attached if the solution containing the initial sample requires a manipulation *to render the solution containing the initial sample satisfactory for slide preparation*, and the Examiner has failed to address these claim limitations.

For at least these reasons, Applicants respectfully submit that independent claim 1, along with those rejected claims which depend therefrom, are not anticipated by Isenstein, and respectfully request reconsideration and withdrawal of the claim rejections under 35 U.S.C. § 102(e) based on Isenstein.

Claim Rejections – 35 U.S.C. § 103

Zahniser and Zweig

Claims 4, 5, 7, 8, and 12-14 stand rejected under 35 U.S.C. § 103(a) for allegedly being obvious over Zahniser in view of USP 6,629,057 (“Zweig”). Claims 4, 8, 12 and 13 have been canceled and Applicants respectfully traverse the rejection of claims 5, 7 and 14, because no combination of Zahniser and Zweig discloses, teaches, or suggests the combination of elements required by these claims.

In particular, as discussed above, Zahniser does not teach or suggest several elements of independent claim 1, from which claims 5, 7 and 14 depend. For example, Zahniser does not teach or suggest attaching a positive designator to the vessel if the solution containing the initial sample is satisfactory for preparing a specimen slide, or attaching a manipulation designator to the vessel if the solution containing the initial sample requires a manipulation in order to render the solution containing the initial sample satisfactory for slide preparation. Zweig does not supplement this deficiency in Zahniser.

Thus, Applicants submit that claims 5, 7 and 14 are not obvious over any proper combination of Zahniser and Zweig, and as such, respectfully request withdrawal of the 35 U.S.C. §103 rejection of these claims.

Zahniser

Claims 21 and 23 stand rejected under 35 U.S.C. § 103(a) for allegedly being obvious over Zahniser. Applicants respectfully traverse this rejection, since Zahniser does not disclose, teach, or suggest the combination of elements required by these claims.

As discussed above, Zahniser does not teach or suggest several elements of independent claim 1, from which claims 21 and 23 depend. For example, Zahniser does not teach or suggest attaching a positive designator to the vessel if the solution containing the initial sample is satisfactory for preparing a specimen slide, or attaching a manipulation designator to the vessel if the solution containing the initial sample requires a manipulation in order to render the solution containing the initial sample satisfactory for slide preparation. The Examiner’s obviousness rationale does not supplement this deficiency in Zahniser.

Thus, Applicants submit that claims 21 and 23 are not obvious over Zahniser, and as such, respectfully request withdrawal of the 35 U.S.C. §103 rejection of these claims.

CONCLUSION

Based on the foregoing remarks, Applicants respectfully submit that the pending claims are now allowable over the cited references. Applicants invite the Examiner to call the undersigned if any remaining issue(s) can be resolved through a telephonic discussion.

Respectfully submitted,
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